

## **REMARKS/ARGUMENTS**

Claims 1-30 are pending in the present application. Claims 1, 11-21, 23, 25, 26, and 28-30 are amended. No new matter has been added by the amendments to the claims. Reconsideration of the claims is respectfully requested.

### **I. 35 U.S.C. § 101**

The Examiner has rejected claims 1-30 under 35 U.S.C. § 101 as being directed towards non-statutory subject matter.

Claim 1 has been amended to tie the claims to another statutory class. Claims 11-20 have been amended to recite a tangible computer storage medium having a computer program product encoded thereon. Claims 21, 23, 25, 26, 28-30 have been amended to recite hardware limitations.

In light of the amendments to the claims, the Applicants respectfully submit that the rejection is now moot. Withdrawal of the rejection is therefore respectfully requested.

### **II. 35 U.S.C. § 102, Anticipation**

The Examiner has rejected claims 1-30 under 35 U.S.C. § 102 as being anticipated by Cohn, U.S. Publication No. 2002/0010651 (hereinafter “*Cohn*”). This rejection is respectfully traversed.

With regard to claim 1, the Examiner states the following:

Cohn discloses a method and corresponding product and apparatus for establishing connections comprising verifying a categorization of a service in a taxonomy, receiving a registration request at the data processing system, the registration request including a service description and an identification era category within the taxonomy in which the service is to be registered, applying one or more canonical service description tests to the service description to determine if the service description should be registered in the category, and registering the service description in the identified category using the data processing system is result of applying the one or more canonical, service description tests is that the service description should be registered in identified category (para.60-66 and fig.3a and 17a-b); the one or more canonical service description tests identify minimum criteria for the category (para.60-66 and fig.3a and 17a-b); registering the service description in the category includes storing the service description and an associated model description in a storage in association with the category (para.60-66 and fig.3a and 17a-b); implemented in a service

broker within at least one network (para.60-66 and fig.3a and 17a-b); the result of applying the one or more canonical service description tests is that the service description should not be registered in the category, a determination is made as to whether a request to add a new category is received (para.60-66 and fig.3a and 17a-b); request to add a new category is received, a determination is made as to whether to add the new category, and wherein if the new category is added, the service description is registered in association with the new category (para.60-66 and fig.3a and 17a-b); one of more canonical service description tests include information identifying minimum requirements of the category regarding one or more of security requirements, privacy requirements and communication protocol requirements (para.60-66 and fig.3a and 17a-b); if the result of applying the one or more canonical service description tests is that the service description should not be registered in the category, the method further comprises: searching the taxonomy for an alternate category in which the service description should be registered, and registering the service description in the alternate category (para.60-66 and fig.3a and 17a-b); searching the taxonomy for an alternate category includes searching one or more of sibling, parent and child categories of the identified category within a predetermined range of the identified category in the taxonomy (para.60-66 and fig.3a and 17a-b); and searching the taxonomy for an alternate category includes searching the taxonomy for a category in which the service description meets requirements of a canonical service description test associated with the alternate category (para.69-66 and fig.3a and 17a-b).

Office Action dated January 16, 2009, pages 4-5.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). All limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). Anticipation focuses on whether a claim reads on the product or process a prior art reference discloses, not on what the reference broadly teaches. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 U.S.P.Q. 781 (Fed. Cir. 1983). In this case, each and every feature of the presently claimed invention is not identically shown in the cited reference, arranged as they are in the claims.

## **II.A. Claims 1, 11, and 21**

Cohn does not properly anticipate the claims 1, 11, and 21 under 35 U.S.C. § 102 because Cohn does not disclose the claim 1 feature of applying by the service broker, one or more

canonical service description tests to the service description to determine if the service description should be registered in the category. Claim 1, is as follows:

1. A method in a data processing system of verifying a categorization of a service in a taxonomy, comprising:
  - receiving by a service broker, a registration request at the data processing system, the registration request including a service description and an identification of a category within the taxonomy in which the service is to be registered;
  - applying by the service broker, one or more canonical service description tests to the service description to determine if the service description should be registered in the category; and
  - registering by the service broker, the service description in the identified category using the data processing system if a result of applying the one or more canonical service description tests is that the service description should be registered in the identified category.

The Examiner relies on the following sections of Cohn to disclose this claim feature:

[0060] The Subscription Sales Process

[0061] Now that the foundation of the DSE has been described, a Subscription Sales Process (SSP) that defines object affiliations can be designed. Object affiliations indicate the level of presence each object is given on each PLI directory. Selling membership subscriptions to providers of business products and services generates revenue. This subscription gives a provider a termed presence in one or more PLI directories. The level of presence in a directory is defined by the number and selection of provider attributes that are exposed on a PLI and presented to the buyer. Presence is divided into three categories: company profile, search result positioning and access to RFPs. The company profile database tables are comprised of a number of fields that can be incrementally added to build an increasingly larger profile. Search result positioning provides a means by which a provider's entry would appear before other entries in a directory search results list.

[0062] There are two typical registration usage scenarios. The first scenario occurs when a Web user navigates to the PLI and clicks a Register hyperlink. The user is immediately redirected to an HTML page containing a list of the available subscription packages offered on the PLI. After the user selects a package, they are presented with a list of fields appropriate for the selected package, and they begin building the company profile. Additionally, the user is asked to categorize the company profile by selecting main categories and sub-categories from the PLI's local taxonomy. Once all data has been collected, an affiliation is created between the company and the PLI and the company's entry is included in directory search results and deal flow (e-mail notification of new RFPs) occurring on that PLI.

[0063] The second scenario occurs when an inside sales agent who represents one

or more PLIs, calls a prospective business provider on the telephone. The sales agent has the option of selling either a subscription on a single PLI or a "multi-pack", that is, a package that consists of subscriptions on multiple PLIs. The advantage of a multi-pack from the provider's perspective is that the provider has the opportunity to gain much wider distribution and reach by leveraging multiple PLIs associated with multiple name brands on the web. To assist in the sales process, the sales agent has the option of selling this multi-pack at a discounted rate.

[0064] To understand the registration process on one or more PLIs, consider the schema depicted in FIG. 3C. The Company table 30 represents the available attributes that can be associated with a provider of business products and services. The CompanyText table 31 is an additional container of related textual content, such as a company description. Similar to the PartnerText table, this construct allows a database administrator to partition the textual data across separate hard drives for performance and fault-tolerance. The CompanyCategory table 32 is used to store references to the categories selected by the user or sales agent to categorize the company. For each PLI on which a subscription is purchased, the company must be categorized using the list of categories associated with that PLI, that is, categories in the PartnerCategory table. Categorization provides a means by which a company can target their marketing efforts within the directory. In the CompanyCategory table, the partnerID column links to the PartnerCategory table and, hence, the Partner table; the categoryID column links to the PartnerCategory table and, hence, the Category table; the topID and subID columns are duplicative of the same fields in the PartnerCategory table and are here only to provide for efficient programming; and finally, the isPrimary column indicates a single main category by which the company can be identified, for example, in search results.

[0065] The Package table 33 describes one or more types of subscriptions that a provider can purchase. A company may have only one subscription on each partner. Each package describes a level of presence afforded the company within the PLI directory (for example, number of company fields shown in the company profile), the level of access provided to the company (for example, the total number of RFPs or highest budget value of an RFP to which the company may respond), the positioning within search results (for example, a provider who purchase a more expensive package appears at the top of a search result list).

[0066] The packageID column uniquely identifies each row in the Package table. The packageName column specifies a short, descriptive title of the package. The isPublic column is used in conjunction with internal customer relation management (CRM) tools, where a value of 0 specifies that this is a private package, available on the internal CRM tool and a value of 1 indicates that this is a public package accessible through the PLI, allowing viral subscriptions generated by standard Web traffic. The packageCost column indicates the cost of the subscription package, the currency of which depends upon the locale of the partner.

Cohn, paragraphs [0060]-[0066]

Cohn et al. discloses a searchable database that gathers and categorizes information collected from multiple websites. When a service provider or service consumer registers with one of the multiple websites, the service provider or service consumer manually categorizes the services provided/sought within a hierarchical set of categories of the searchable database. Subscribers to the database can customize their “level of presence” within the database. This “level of presence” can be a priority of the subscriber’s information when a database search is performed, or a particular ceiling value of desired services displayed when a database search is performed.

Cohn does not disclose the claim features, as they are currently recited. That is, Cohn fails to recite any steps that would verify categorization, and instead relies solely on the user’s entered classification according to the existing categories. As stated in Cohn, “the user is asked to categorize the company profile by selecting main categories and sub-categories from the PLI’s local taxonomy.” See Cohn, para. 62.

As discussed previously, Cohn merely receives a category selection and does not apply one or more canonical service description tests to determine that the service description should be registered in the identified category. Cohn relies on the user to determine what category the item should be listed in.

Conversely, the present invention, and claim 1 in particular, makes use of canonical service description tests which designate minimum requirements for a service to be classified into a corresponding classification. Based on the canonical service description tests, it can be determined whether a service that wishes to be classified into a particular classification of a taxonomy on a service broker meets the minimum requirements for that classification. Furthermore, the use of canonical service description tests ensures that all services classified into a particular classification have a minimum level of functionality that will allow them to function properly when invoked.

Cohn does not disclose the claim 1 feature of applying by the service broker, one or more canonical service description tests to the service description to determine if the service description should be registered in the category. Therefore, Cohn does not properly anticipate

the claim 1 under 35 U.S.C. § 102. Withdrawal of the rejection is therefore respectfully requested.

Claims 11 and 21 recite features similar to those found in claim 1. Therefore, by virtue of reasons similar to those presented above, Cohn does not properly anticipate claims 11 and 21 under 35 U.S.C. § 102. Withdrawal of the rejection is therefore respectfully requested.

## **II.B. Claims 2, 12, and 22**

With regard to claims 2, 12 and 22, Cohn does not teach wherein the one or more canonical service description tests identify minimum criteria for the category. As discussed previously, Cohn is only concerned with whether the user selected category has related subcategories. There is no test applied by Cohn that identifies minimum criteria for the selected category. Cohn discloses nothing that would be equivalent to applying canonical service description tests that identify minimum criteria for the category.

Claim 2 depends from claim 1. Claim 12 depends from claim 11. Claim 22 depends from claim 21. Cohn does not disclose all of the features of claims 2, 12, and 22, at least by virtue of their dependency on the corresponding independent claims.

Cohn does not properly anticipate the claims 2, 12, and 22 under 35 U.S.C. § 102. Withdrawal of the rejection is therefore respectfully requested.

## **II.C. Claims 4, 14, and 24**

With regard to claim 4, 14, and 24, Cohn does not teach wherein the method is implemented in a service broker within at least one network. As stated above, Cohn teaches that a user must categorize new entries. Thus, the process of determining whether a service description should be registered in a certain category not only occurs outside of the service broker, but outside Cohn's data processing system entirely. As disclosed by Cohn, the process of determining whether a service description should be registered in a certain category is an entirely human evaluation.

Claim 4 depends from claim 1. Claim 14 depends from claim 11. Claim 24 depends from claim 21. Cohn does not disclose all of the features of claims 4, 14, and 24, at least by virtue of their dependency on the corresponding independent claims.

Cohn does not properly anticipate the claims 4, 14, and 24 under 35 U.S.C. § 102. Withdrawal of the rejection is therefore respectfully requested.

**II.D. Claims 3, 5-10, 13, 15-20, 23 and 25-30**

Claims 3 and 5-10 depend from claim 1. Claims 13 and 15-20 depend from claim 11. Claims 23 and 25-30 depend from claim 21. Cohn does not disclose all of the features of claims 3, 5-10, 13, 15-20, 23 and 25-30, at least by virtue of their dependency on the corresponding independent claims. Therefore, by virtue of reasons similar to those presented above, Cohn does not properly anticipate the claims 3, 5-10, 13, 15-20, 23 and 25-30 under 35 U.S.C. § 102, at least by virtue of their dependence from the underlying independent claims. Withdrawal of the rejection is therefore respectfully requested.

**III. Conclusion**

It is respectfully urged that the subject application is patentable over the cited reference and is now in condition for allowance.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,

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